



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,349	07/14/2003	John D. Donnelly	71506-0003	1348

20915 7590 01/25/2005

MCGARRY BAIR PC
171 MONROE AVENUE, N.W.
SUITE 600
GRAND RAPIDS, MI 49503

EXAMINER


JOHNSON, BLAIR M

ART UNIT	PAPER NUMBER
----------	--------------

3634

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

 Office Action Summary	Application No.	Applicant(s)	
	10/604,349	DONNELLY, JOHN D.	
	Examiner	Art Unit	
	Blair M. Johnson	3634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) 13-16, 26, 27, 40-43, 53 and 54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 17-25, 28-39 and 44-52 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

Claim Rejections - 35 USC § 112

Claims 6,22-24,33 and 49-51 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The operation of the bias adjuster and the spring together is not understood. It is disclosed that these two features can operate together. However, it appears that the bias adjuster 68 determines a fixed position of the arm 60 which not permit the spring 66 to have any effect on the arm's position.

The "complex pulley" has not been adequately disclosed.

Also, cable brake of Figs. 10 and 11 is not understood. It is not disclosed how the brake is supported, supported for reciprocal movement, maintained in position, etc.

Claims 1-12 and 17-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, "A door", preamble, is said to be recited. However, in the body of the claim, there is no structure positively recited which represents the actual door itself, thereby rendering the scope of the claim ambiguous.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the complex pulley

Art Unit: 3634

must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Election/Restrictions

Applicant's traverse is noted. However, the adjusters are completely different. It is maintained that if a reference were found that rendered obvious the adjuster of Figs. 5, it would not also read on the embodiment of Fig. 8, and vice versa. The restriction is proper. Claims 26 and 53 are improperly listed as reading on the elected embodiments.

Art Unit: 3634

These claims will not be examined. The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3,5-8,10-12,17,25,28-30,32-35,37-39,44 and 52 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hawks et al.

See the embodiment of Fig. 2. See cable 32', counterweight 14, pulleys 44,48, bracket 34, and covers, unnumbered, both removable and the side jamb which has the opening for the cable 32'. Since the door has not actually be recited, claims 3 and 30 do not contribute structural limitations. See also the adjuster/dampening system, Fig. 3, which is mounted to the door frame.

Claims 1-3,5,6,12,28-30,32,33 and 39 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Plum et al.

See cable 12, lead weight 16, pulley 18 and bracket 14. The term "complex pulley system" has not been defined, as discussed above, and is met as best understood by the pulley 18. Regarding the adjuster, the number of weights is variable based on the weight of the door, paragraph 0017.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawks et al or Plum et al.

The material of the cable is clearly an obvious design choice. The use of nylon would have been obvious based on economics, it's quiet nature, etc.

Claims 9 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawks et al in view of Plum et al.

The use of lead for a weight is well known, as illustrated by Plum et al in paragraph 0017. It would have been obvious to ensure that the weight of Hawks et al would be made of lead based on lead's low cost per weight ratio.

Claims 7-11 and 34-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Plum et al in view of Hawks et al.

Plum does not hide his weight system in the door jamb. However, Hawks et al does teach such a feature for obvious reasons. It would have been obvious to modify Plum whereby his weight system is located in the jamb so as to hide the mechanism.

Allowable Subject Matter

Claims 18-21 and 45-48 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Art Unit: 3634

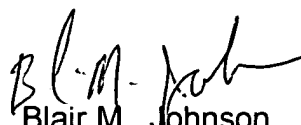
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blair M. Johnson whose telephone number is (703) 308-0526. The examiner can normally be reached on Mon.-Fri., 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on (703) 308-2486. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Blair M. Johnson
Primary Examiner
Art Unit 3634

BMJ
1/24/05